Remarks

Claims 13, 15-16, 47-54 and 69-80 stand rejected under *35 U.S.C. §103(a)* as being unpatentable over U. S. Patent No. 6,529,146 to Kowalski et al. ("Kowalski") in view of U. S. Patent No. 6,902,114 to Hashimoto et al. ("Hashimoto"). Claims 14 and 17-18 stand rejected under *35 U.S.C. §103(a)* as being unpatentable over Kowalski as modified by Hashimoto in view of U. S. Patent No. 5,764,774 to Liu ("Liu").

Kowalski, the primary reference, teaches "a system and method for simultaneously encoding a data signal in multiple formats and at multiple bit rates." An object of the Kowalski system is to encode a data signal in such manner that a data signal can be accessed by a larger percentage of end users:

> Currently, there are a number of encoding formats that are used to perform data compression, because each format offers certain advantages and disadvantages over the others for particular applications. Unfortunately, these formats are typically incompatible with each other. Thus, if a signal is broadcast in one encoded format, only those end users who receive the signal and have the appropriate decoder will be able to decode and view the data. Accordingly, it is desirable to encode a data signal in multiple formats to be accessible by a larger percentage of the end users. *Column 1, Lines 49-58, Kowalski U. S. Patent No. 6,529,146 B1.*

According to *MPEP §2143*, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The pending independent claims of the present application are as follows:

13. (Currently Amended) A symbol generator including:
a graphical user interface including a first data input area facilitating entry of a designator for a formatted file ~~data~~, and a second data input area facilitating entry of command data;
an encoder encoding into at least one symbol a formatted file in accordance with said designator ~~input formatted file data~~, and a command in accordance with said input command data.

47. (Original) A symbol generator including:
a prompting user interface including a first data input area and a second data input area, said first data input area receiving information pertaining to a formatted file to encode, said second data input area receiving information pertaining to a number of bar codes to encode;
wherein said symbol generator encodes formatted file data in accordance with information input into said first data input area and encodes a number of bar codes in accordance with information input into said second data input area.

52. (Currently Amended) A symbol generator comprising:
a user interface allowing a user to input information respecting data to encode, the user interface including a data input area for designating a destination directory, the destination directory designating a storage location for data produced by decoding of symbol encoded by said symbol generator;
an encoder encoding a set of bar codes in accordance with said input information;
wherein said encoder, in encoding said bar code symbol set encodes in each symbol of said set a field indicating a total number of symbols of said set and a ~~filed~~ field indicating the number in said set of said present ~~field~~ bar code symbol set.

69. (Currently Amended) A symbol generator comprising:
a graphical user interface including a first data input area facilitating designation of ~~one or more out of a plurality of viewable files~~ at least one file available for encoding, the ~~plurality of viewable files available for encoding each being of a type selected from the group consisting of viewable document files, viewable image files, and viewable video files,~~ symbol generator being configured so that types of files available for encoding by said symbol generator include at least one of document files, image files, and video files, the graphical user interface including a second data input area facilitating entry of command data, the second data input area enabling a user to ~~designated~~ designate whether a ~~viewable~~ file designated for encoding in said first data input area will be displayed at the time when a symbol encoding the ~~viewable~~ file is read; and
an encoder encoding into at least symbol at least one of a document file, an image file, and a video file in accordance with designating information input into said first data input area, and further encoding into said second data input area command data, if any, input into said second data input area.

73. (Currently Amended) A symbol generator comprising:
a graphical user interface including a first data input area facilitating designation of one or more ~~out of a plurality of viewable~~ files available for encoding, the ~~plurality of viewable files available for encoding each being of a type selected from the group consisting of viewable document files, viewable image files, and viewable video files,~~ symbol generator being configured so that types of files available for encoding by said symbol generator include at least one of a document file, an image file, and a video file, the graphical user interface including a second data input area facilitating entry of command data, the second data input area enabling a user to input a command for encoding which when decoded and run by a reader causes a reader to download from a server a ~~viewable~~ file of a type selected from the group consisting of ~~viewable~~ document files, ~~viewable~~ image files, and ~~viewable~~ video files; and
an encoder encoding into at least one symbol ~~any file that is designated in said first data input area, and any command that is input into said second data input area.~~ at least one of the following: (a) a file of a file type selected from the group consisting of a document file, an image file, and a video file; and (b) a command to download from a server a file of a file type selected from the group consisting of a document file, an image file, and a video file.

77.   (Currently Amended) A symbol generator comprising:
a graphical user interface including a first data input area facilitating designation of ~~one out of a plurality of~~ at least one ~~files~~ file available for encoding, the ~~plurality of files~~ symbol generator being configured so that available for encoding ~~being~~ by said symbol generator are files of first, second and third different file types; and
an encoder encoding into at least one symbol a file in accordance with designating information input into said first data input area, and further encoding into said at least one symbol a command which when run by a reader that reads said at least one symbol causes said reader to execute one of a plurality of file opening programs, the one file opening program which is executing being responsive to a determination of a file type of said file that is encoded into said symbol.

In order to establish a *prima facie* case of obviousness an Examiner must demonstrate that there is suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the references or to combine reference teachings. *MPEP §2143*. Under *MPEP §2144*, the strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. *In re Sernaker*, 702 F.2d 989 (Fed. Cir. 1983). The Examiner must present a convincing line of reasoning supporting the rejections. *Ex parte Clapp*, 227, USPQ 972 (Bd. Pat. App. & Inter. 1985) also cited in *MPEP §2144*. The Examiner must present a convincing line of reasoning as to why the skilled artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227, USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) cited in *MPEP §2142*.

In the outstanding office action of November 2, 2005, the Examiner has presented a rationale for combining Kowalski and Hashimoto as follows:

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Hashimoto et al. into the system as taught by Kowalski et al. for intended use (i.e., encoding data into barcode symbols). Furthermore, such modification would decrease occurrence of read errors due to the division of data into a plurality of barcodes (i.e., at the scanning time, a distance is kept between the bar code reader and a bar code label, whereby a beam is scattered and thus the scan width widens, but the spot worsens, degrading the read accuracy. Therefore, to ensure precise read, the original data needs to be placed in a proper bar code length), thus providing a more accurate system. *November 2, 2005 Office Action, Pages 6-7.*

Applicants respectfully assert that the above proposed modification does not establish *prima facie* obviousness. It is noted with respect to the Examiner's proposed rationale for modifying Kowalski in accordance with Hashimoto that the Examiner has made reference to an intended use of a secondary reference ("It would have been obvious to incorporate the teachings...for intended use [*i.e.,* encoding data into barcode symbols]"). However, the Examiner's rationale does not consider the intended use of the primary reference being modified. In determining whether *prima facie* obviousness has been established it is appropriate to consider the intended purpose of the primary reference. If a proposed modification would render the prior art invention *being modified* unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. (Emphasis added) *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) cited in *MPEP §2143.01*

The purpose of the primary reference Kowalski is specifically described. Kowalski describes a "system and method for simultaneously and synchronously encoding a data signal in multiple formats and at multiple bit rates." *Kowalski, Abstract* (repeated in summary). Further the "data signal" of Kowalski is specifically defined: "The term "data signal" as used herein is intended to refer to any suitable continuous stream media." *Column 3, Lines 37-40.* Encoding of a continuous stream data signal into multiple formats and bit rates allows a broadcast encoded continuous stream data signal to be received by an increased percentage of end users having different continuous stream data signal decoding capabilities: "Thus, if a signal is broadcast in one encoded format, only those end users who receive the signal and have the appropriate decoder will be able to decode and view the data. Accordingly, it is desirable to encode a data signal in multiple formats to be accessible to a larger percentage of end users." *Kowalski, Column1, Lines 53-58.* While the Examiner has proposed that there is motivation to modify the continuous data stream signal encoding of Kowalski into the form of a symbol encoding, applicants respectfully assert that the Examiner has not adequately demonstrated that there is motivation to modify Kowalski. In view of the intended purpose of Kowalski (to encode a continuous stream data signal), applicants respectfully note that if continuous stream data encoding of Kowalski were modified into the form of encoding data

into a symbol, then Kowalski would no longer be satisfactory for its intended purpose. Kowalski would no longer be functional as a continuous data stream encoder and the intended purpose of Kowalski of encoding for broadcast to multiple end users a continuous stream data signal into multiple formats and bit rates would no longer be satisfied. As has been indicated, if a proposed modification would render the prior art invention *being modified* unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. (Emphasis added) *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) cited in *MPEP §2143.01*

Applicants believe that the proposed modification of the Examiner would not be satisfied even if one were to accept the proposition of the Examiner that broadcast continuous stream data signal encoding as described in Kowalski is suggestive of symbol encoding as described in Hashimoto. Hashimoto, Fig. 3 shows a symbol encoding selected information in only one format and does not suggest that selected information for encoding is to be encoded in multiple bar code formats. While Hashimoto mentions encoding information to be encoded into a plurality of symbols, Hashimoto does not state that a format of symbol encoding information is to be varied. Accordingly, a skilled artisan even if motivated to modify continuous data stream encoding of Kowalski in accordance with Hashimoto's teachings relative to data encoding, would apparently be motivated in view of Hashimoto to encode data to be encoded into a single format, and not a plurality formats. With such modification of Kowalski under an alternative analysis, the intended purpose of Kowalski, *i.e.,* to encode a broadcast continuous data signal into "multiple formats" so that the signal is accessible by an increased percentage of end users would also not be satisfied.

The Examiner's attempt to establish *prima facie* obviousness of the claims is not sufficient for reasons other than a lack of motivation to modify a reference. For *prima facie* obviousness to be established, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner has not established and has not even alleged that the prior art has all of the elements of any pending claim.

For example, regarding claim 13, the Examiner has rejected claim 13 under *35 U.S.C. §103(a)* over Kowalski as modified by Hashimoto. Claim 13 recites among other elements "an encoder encoding into at least one symbol...in accordance with said input command data." The Examiner has not demonstrated and has not alleged that the prior art references have the above combination of elements. At least because the Examiner has not demonstrated, and has not even alleged that the relied upon references alone or in combination teach or suggest "an encoder encoding into at least one symbol...in accordance with said input command data" in the context of the remaining elements of claim 13 it is believed that the Examiner has not demonstrated a case of *prima facie* obviousness as to claim 13. The Examiner will note that claim 13 has been amended. In that the amendments to claim 13 either broaden a claim element or clarify a claim element, the amendments to claim 13 should not be regarded as narrowing claim amendments.

Regarding claim 47, the Examiner has rejected claim 47 under *35 U.S.C. §103(a)* over Kowalski as modified by Hashimoto. Claim 47 recites among other elements "a data input area receiving information pertaining to a number of bar codes to encode." The Examiner has not demonstrated and has not alleged that the prior art references have the above combination of elements. At least because the Examiner has not demonstrated, and has not even alleged that the relied upon references alone or in combination teach or suggest "a data input area receiving information pertaining to a number of bar codes to encode" in the context of the remaining claim elements, it is believed that the Examiner has not demonstrated a case of *prima facie* obviousness as to claim 47.

Regarding claim 52, the Examiner has rejected claim 52 under *35 U.S.C. §103(a)* over Kowalski as modified by Hashimoto. Claim 52 as amended recites among other elements "a user interface including a data input area for designating a destination directory." The Examiner has not demonstrated and has not alleged that the prior art references have the above combination of elements. At least because the Examiner has not demonstrated, and has not even alleged that the relied upon references alone or in combination teach or suggest

"a user interface including a data input area for designating a destination directory" in the context of the remaining claim elements, it is believed that the Examiner has not demonstrated a case of *prima facie* obviousness as to claim 52.

Regarding claim 69, the Examiner has rejected claim 69 under *35 U.S.C. §103(a)* over Kowalski as modified by Hashimoto. Claim 69 recites among other elements "an encoder encoding into at least one symbol...command data, if any, encoded into said second data input area" in the context of the remaining elements of claim 69." The Examiner has not demonstrated and has not alleged that the prior art references have the above combination of elements. At least because the Examiner has not demonstrated, and has not even alleged that the relied upon references alone or in combination teach or suggest "an encoder encoding into at least one symbol...command data, if any, encoded into said second data input area" in the context of the remaining claim elements, it is believed that the Examiner has not demonstrated a case of *prima facie* obviousness as to claim 69. The Examiner will note that claim 69 has been amended. In that the amendments to claim 69 either broaden a claim element or clarify a claim element, the amendments to claim 69 should not be regarded as narrowing claim amendments.

Regarding claim 73, the Examiner has rejected claim 73 under *35 U.S.C. §103(a)* over Kowalski as modified by Hashimoto. Claim 73 recites among other elements "a second data input area enabling a user to input a command for encoding." The Examiner has not demonstrated and has not alleged that the prior art references have the above combination of elements. At least because the Examiner has not demonstrated, and has not even alleged that the relied upon references alone or in combination teach or suggest "a second data input area enabling a user to input a command for encoding." in the context of the remaining elements of claim 73, it is believed that the Examiner has not demonstrated a case of *prima facie* obviousness as to claim 73. The Examiner will note that claim 73 has been amended. In that the amendments to claim 73 either broaden a claim element or clarify a claim element, the amendments to claim 73 should not be regarded as narrowing claim amendments.

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Regarding claim 77, the Examiner has rejected claim 77 under *35 U.S.C. §103(a)* over Kowalski as modified by Hashimoto. Claim 77 recites among other elements "a command which when run by a reader that reads said at least one symbol causes said reader to execute one of said file opening programs." The Examiner has not demonstrated and has not alleged that the prior art references have the above combination of elements. At least because the Examiner has not demonstrated, and has not even alleged that the relied upon references alone or in combination teach or suggest "a command which when run by a reader that reads said at least one symbol causes said reader to execute one of said file opening programs" in the context of the remaining elements of claim 77, it is believed that the Examiner has not demonstrated a case of *prima facie* obviousness as to claim 77. The Examiner will note that claim 77 has been amended. In that the amendments to claim 77 either broaden a claim element or clarify a claim element, the amendments to claim 77 should not be regarded as narrowing claim amendments.

The rejections of claims 13, 15-16, 47-54, and 69-80 are believed to be insufficient and improperly made for reasons in addition to those mentioned herein above. In addition to the claim rejections being insufficient for purposes of demonstrating *prima facie* obviousness, the claim rejections of claims 13, 15-16, 47-54, and 69-80 are presented in the form of an omnibus rejection, which is improper under *MPEP §707(d)*. Also, the rejections of claims 13, 15-16, 47-54, and 69-80 are presented in a form that in inconsistent with the requirements of 37 CFR §1.104.

MPEP §707(d) states that a plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group. Notwithstanding *MPEP §707(d)* the entirety of the Examiner's presented rejection of claims 13, 15-16, 47-54, and 69-80 is as follows:

> Claims 13, 15-16, 47-54, and 69-80 are rejected under *35 U.S.C. §103(a)* as being unpatentable over Kowalski et al. (US 6,529,146 B1) in view of Hashimoto et al. (US 6,902,114 B2).
> Re claims 13, 15-16, 47-54, and 69-80: Kowalski et al. discloses a symbol generator including: a graphical user interface 44 including a first data input area 96 facilitating entry of

formatted file data, and a second data input area 80 facilitating entry of command data; an encoder 32 encoding into at least one encoding format a formatted file in accordance with the input formatted file data, and a command in accordance with the input command data (fig. 6; col. 7, line 40 through col. 8, line 62); wherein the user specifies all desired parameters and the encoding system configured to encode the inputted data according to the user's setting or the options selected by the user (figs. 5 and 8; col. 5, line 3 through col. 7, line 39 and col. 9, lines 18-65).

Kowalski et al. is silent with respect to encode the formatted file into at least one symbol; automatically changes a number of symbols to encode depending; indicate a number of symbols to be encoded; encoding a set of barcodes, a field indicating a total number of symbols of the set, respectively.

Hashimoto et al. teaches an encode method and system where the user specifies all setup value; the capacity of the inputted data is greater than the predetermined number, the data is encoded into more than one barcode; wherein each of the encoded barcode includes a total number of barcodes making up the setting group and a serial number indicating the order of the barcode in the barcodes making up the setting group (figs. 4-7; col. 8, line 1 through col. 10, line 41).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Hashimoto et al. into the system as taught by Kowalski et al. for intended use (i.e., encoding data into barcode symbols). Furthermore, such modification would decrease occurrence of read errors due to the division of data into a plurality of barcodes (i.e., at the scanning time, a distance is kept between the bar code reader and a bar code label, whereby a beam is scattered and thus the scan width widens, but the spot worsens, degrading the read accuracy. Therefore, to ensure precise read, the original data needs to be placed in a proper bar code length), thus providing a more accurate system.

Kowalski et al. as modified by Hashimoto et al. has been discussed above and further discloses the graphical interface may include additional input boxes to allow for input of information with respect to other parameters (col. 8, lines 16-18), but is silent with respect to the user indicating number of symbols to be encoded, number of bytes of data into a to-be encoded barcode, and whether a viewable field designated for encoding will be displayed at the time when a symbol encoding the viewable file is read, respectively.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the additional input boxes of Kowalski et al./Hashimoto et al. to provide the user with the flexibility in selecting desired specific parameters, thus providing a desired encoding result.

It is believed that the rejection of claims 13, 15-16, 47-54, and 69-80 are presented as an improper omnibus rejection. Claims 13, 15-16, 47-54, and 69-80 are presented as claims of a single group. However, the presented rejection is not equally applicable to each of claims 13, 15-16, 47-54, and 69-80. In view of the above it is respectfully asserted that the Examiner has presented a rejection to a group of claims at once where the rejection is not equally applicable to all claims of the group.

Further, in rejecting a claim for obviousness based upon a reference describing inventions other than the invention claimed, the Examiner must designate as nearly as practicable the particular part of the reference relied upon. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. *37 C.F.R.*

§1.104(c). While the Examiner has made reference to particular portions of Kowalski and Hashimoto, the Examiner has not specified any claim with respect to the references cited. If the Examiner will maintain the rejection of claims 13, 15-16, 47-54, and 69-80, the Examiner is respectfully requested to explain which claims the various rejections apply.

Regarding the claims discussed herein, the applicants' selective treatment and emphasis of independent claims of the application should not be taken an indication that the applicants believe that the Examiner's dependent claim rejections are otherwise sufficient. In fact, it is noted in the office action that the dependent claims are rejected without substantial, and in certain instances, without any reference to the limitations of the dependent claims in combination with the base claim elements. In rejecting claims for want of novelty or for obviousness, the Examiner must cite the best references at his/her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. *37 C.F.R. 1.104(c)(2)*. If the Examiner will maintain the rejections of the claims including the dependent claims, the Examiner is respectfully requested to specify which claims are being rejected when references are discussed. The Examiner is further respectfully requested to specify each claim, including each dependent claim in making the rejections in accordance with the requirements of *37 C.F.R. §1.104*.

Also, while the applicants herein may have highlighted in certain instances herein specific elements of a claim for purposes of demonstrating an insufficiency of a claim rejection, the applicants emphasis on a specific claim element for such limited purposes should not be taken as an indication that the applicants have asserted that a claim is allowable for its recital of a specific element out of the context of the combination of elements recited.

The applicants herein amend the specification in minor respects. For clarity, amendments are presented in the form of a substitute specification. While limitations of a patent specification are not to be imported into the claims, applicants amend the formatting

and wording of the application slightly to further emphasize that limitations of the specification are not to be imported into the claims. Specifically, certain sections of text are moved into the Detailed Description section of the application. Regarding the term "invention" in locations throughout the specification, the Examiner will appreciate that the lengthy specification which has formed support for numerous patent claims describes several different inventions unrelated to the invention being claimed. None of the amendments presented herein contain new matter.

While the applicants have concentrated on the independent claims for purposes of demonstrating insufficiency of the Examiner's rejections, the lack of discussion respecting the dependent claims should not be taken as an indication that the applicants believe that the rejections of the dependent claims are otherwise correct. Applicants expressly reserve the right to present arguments supporting patentability of the dependent claims in a future response. Further, while the applicants herein may have highlighted a particular claim element for purposes of demonstrating an insufficiency of an examination on the part of an Examiner, the applicants highlighting of a particular claim element for such purpose should not be taken to indicate that the applicants have taken the position that a particular claim element constitutes the sole basis for patentability out of the context of the various combinations of elements of the claim or claims in which it is present.

The Examiner will note that claims 81-88 have been added. Claims 81-88 are believed to be allowable in that they recite combinations of elements not shown or suggested in the cited prior art. None of the amendments presented herein contain new matter.

Accordingly, in view of the above amendments and remarks, applicants believe all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

If the Examiner believes that contact with applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicants' representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Respectfully submitted,

WALL MARJAMA & BILINSKI LLP

Date: May 2, 2006
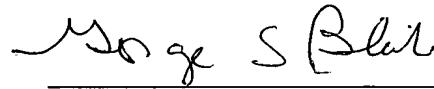
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